

metal strengthening insert, said insert and/or said loop (21) being] duplicate molded in said rigid intermediate layer (9E).

26. (Amended) Sole according to claim 1, wherein said rigid intermediate layer[, or rib](9) can allow mechanical attachment of an insert cooperating with an associated binding for assembly of said sole to an element such as a ski, cycle pedal, etc., said insert being duplicate molded in said rigid intermediate layer [9)] (9).

27. (Amended) Sole according to claim 21, wherein said intermediate layer[, or rib] (9F) can allow mechanical attachments of studs in a screw-in configuration in an application to golf shoes.

Cancel Claim 29.

#### REMARKS

Favorable reconsideration of the present application is respectfully requested.

Claim 29 has been cancelled. Claims 1-28 and 30-32 remain active in the application, of which Claims 28 and 30-32 represent new claims which were not present in the issued patent. Claims 1-28 and 30-32 all stand rejected.

#### I. REISSUE RECAPTURE

Claims 28 and 32 stand rejected under 35 U.S.C. § 251 as being "an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." This rejection is again respectfully traversed for the reasons set forth below.

The same reissue recapture rejection was applied against Claim 28 and presently cancelled Claim 29 in the Office Action of November 13, 2002. In response, Applicants

pointed out that the claims do not attempt to improperly recapture previously surrendered subject matter because they are narrower than the cancelled claim scope in an aspect germane to a prior art rejection in the original prosecution. Specifically, original application Claim 1 recited an intermediate layer or rib, but included no recitation concerning the extent of the area of the intermediate layer. Claim 1 was cancelled in favor of application Claim 27, which also recited an intermediate layer, but did not recite the degree or area of extent of the intermediate layer. In the Amendment After Final Rejection filed on September 2, 1994, on the other hand, the intermediate layer limitation was narrowed to recite, for the first time, the area of extent of the intermediate layer, i.e., that the intermediate layer extends "over an entire surface of said ground contact layer." Thus, the claim which was amended or cancelled during prosecution in order to gain patentability included no recitation concerning the extent of the area of the intermediate layer, whereas claims 28 and 32 each recite an intermediate layer which extends over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe -- a material narrowing in an aspect germane to the rejection.

In response to the Examiner's reliance on *Pannu v. Storz Instruments, Inc.*, Applicants previously pointed out that the Examiner's reliance on this case is misplaced because in *Pannu*, the "narrowing aspect of the claim on reissue . . . was not related to the shape of the haptics [surrendered subject matter], but rather, the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening." 59 USPQ2d at 1600-1601. That is, *Pannu v. Storz* does not stand for the proposition that the patentee is estopped from obtaining broadened reissue claims that do not contain that precise limitation which was added for the purpose of securing

allowance, but instead simply stands for the proposition that an added limitation must be related to the broadening.

Nonetheless, the Examiner has again rejected Claims 28 and 32 based upon reissue recapture estoppel because the “elimination of the limitation of [over the entire surface] results in recapture since this limitation was added to overcome a rejection” (paragraph 1, last sentence):

Absent any contrary evidence, an applicant who adds such a limitation for the purpose of securing allowance is considered to have abandoned the right to claims in which that limitation has been broadened or discarded. *After the application matures into a patent, the patentee is estopped from obtaining broadened reissue claims that do not contain that precise limitation.* (paragraph 17; paragraph bridging pages 15 and 16, emphasis added).

It is thus the Examiner’s position that a limitation added for the purpose of securing allowance *cannot be broadened in any way* by way of reissue, even if it remains narrower than the cancelled claim in an aspect germane to the rejection precipitating the narrowing. Applicants respectfully submit that this rejection does not comport with the state of the law, and is improper.

As explained in the response filed on July 12, 2002, the U.S. PTO position regarding reissue recapture is set forth in M.P.E.P. § 1412.02, which references *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997). As is there explained, when analyzing recapture, one first applies a two-step test to determine if the claims have been broadened with respect to the patent claims, and whether this broadening relates to surrendered subject matter. *However, this does not end the matter.* One must then separately determine whether this broadening is barred by reissue recapture, i.e., whether the patentee is attempting to reclaim the surrendered subject matter. Thus, a broadened reissue claim will escape the recapture rule so long as it is “narrower [than the claim cancelled from the original claims] in an aspect germane to [a]

prior art rejection.” M.P.E.P. § 1412.02, subheading entitled “REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME RESPECTS, BUT NARROWER IN OTHERS” (quoting *In re Clement* at 45 USPQ2d 1165). This is entirely consistent with the prohibition against attempting to reclaim the surrendered subject matter since a reissue claim which is narrower than the claim cancelled from the original claims in an aspect germane to a prior art rejection does not recapture the same claim scope as was surrendered.

Thus it is simply incorrect for the Examiner to take the position that “after the application matures into a patent, the patentee is estopped from obtaining broadened reissue claims that do not contain that precise limitation.” Rather, the position of the PTO, as expressed in the MPEP, is that the patentee is only estopped from obtaining broadened reissue claims that are not narrower than the claim cancelled from the original claims in an aspect germane to a prior art rejection. This is not the case in the present reissue application since, as compared to the claim scope of the original application which was surrendered to gain patentability, the reissue claims 28 and 32 are narrowed as to require a substantial limitation as to the area extent of the intermediate layer relative to the ground contact layer.

The Examiner has alleged that the claims are in fact not narrower than a cancelled claim in an aspect germane to a prior art rejection because of the cancellation of original application Claim 25. However, it is noted that original application Claim 25 simply recited that each of the layers constituting the sole “extends or does not extend over its entire surface.” Application Claim 25 thus did not further limit application Claim 1 in any way -- it included layers of any extent. Since Claim 25 did not further limit application Claim 1 in any way, its cancellation did not surrender any subject matter.

As for *In re Byers* (109 USPQ 53 (CCPA, 1956)), upon which the Examiner has also relied, it is noted that this case merely holds that “since the deliberate cancellation of a claim

in order to obtain a patent constitutes a bar to the obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that cancelled only in being broader.” 109 USPQ at 56. Here, on the other hand, Applicants are not attempting to acquire claim language broader than that which was cancelled in the original patent application. Instead, Claims 28 and 32 are narrower than the cancelled claim in an aspect germane to a prior art rejection.<sup>1</sup>

## II. REJECTIONS UNDER 35 U.S.C. § 112

Regarding the rejection of Claims 17-20, 24 and 30-32 under 35 U.S.C. § 112, first paragraph (paragraph 4),<sup>2</sup> the Examiner has alleged that there is no basis in the specification for a shoe sole having both a comfort layer and an intermediate layer constituted by a succession of rigid inserts. The Examiner has based this allegation upon the lack of an illustration of a comfort layer in Figures 9-11 (and on the comfort layer points 8B in Figure 16), and on the statement on column 5 that “the comfort layer 8 is omitted.”

However, Applicants respectfully submit that this rejection represents a misinterpretation of the patent disclosure, as it would be understood by those skilled in the art. Patent Claims 17-20 and 24 correspond to original application Claims 8-11 and 15, and so provide support under 35 U.S.C. § 112 for their own recitations, i.e., a comfort layer in combination with an intermediate layer comprising “a succession of rigid inserts” (Claim 17), or “two arc-shaped recesses” (Claim 19).

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<sup>1</sup>Concerning *Riley v. Broadway-Hale Stores* and *In re Weiler* (page 16 of the Office Action), it is noted that *Riley* is not a decision of the Federal Circuit and that *In re Weiler* merely chastises the Board of Appeals for failing to explicitly state a statutory basis for a “no error” rejection. *Weiler* thus has nothing to do with reissue recapture estoppel.

<sup>2</sup>The rejection of Claim 29 has been rendered moot by its cancellation.

In addition there is nothing in the specification which is inconsistent with the recitations of these claims. For example, the “Summary of the Invention” describes a sole incorporating at least three layers, including an intermediate layer and a comfort layer (column 3, lines 10-16). It is further noted that in the “Brief Description of the Drawings”, Figures 7 and 8 are described as showing an embodiment in which “the comfort layer is not shown.” *That is, the comfort layer is present but not illustrated.* In the same way, “the comfort layer is not illustrated” in Figures 9, 10 and 11 (column 3, lines 60-67). It is within this context that the description that “the embodiment shown in Figs. 7 and 8 (in which the comfort layer 8 is omitted)” must be understood. The illustration of the comfort layer 8 is omitted in the drawings, but it remains present in the invention. To read the specification otherwise would ignore the Summary of the Invention and the originally filed claims, both of which refer to a comfort layer in combination with inserts.

Regarding the “stops” 12 and 13 in Figure 11, Applicants note that the specification describes that they are formed from the contact layer 7, and that Figure 11 does not suggest otherwise. While the layer 9C appears to be intermediate the stops 12 and 13 in Figure 11, this is simply a function of the selected sectional view. It does not imply that the stops 12 and 13 are separate distinct elements from the contact layer 7.

Concerning the rejection under 35 U.S.C. § 112, second paragraph (paragraph 5 of the Office Action), Claims 14, 17, 19 and 23-27 have been amended to delete reference to a “rib.” Beyond this, Claim 20 has been amended to make clear that the “latter” is the stops; Claim 21 has been amended to delete the phrase reciting that the balanced heel piece replaces the outer heel piece of the shoe; Claim 24 has been amended to recite a “comfort layer” rather than a comfort zone, and to delete the phrase “clear it by a value equal to the thickness of said comfort layer to be produced”; Claim 25 has been amended to recite structural features.

Otherwise, the objections to the claims under 35 U.S.C. § 112, second paragraph are respectfully traversed, as follows:

Claims 17, 19 and 24 were original claims and represent original disclosure. Therefore, the phrase “entire” as added during prosecution, must be understood by those skilled in the art as excepting features corresponding to those of Claims 17, 19 and 24. Regarding the “balanced heel piece” in Claim 21, it is noted that the balanced heel piece is described at column 5, lines 47-53 in the specification. Concerning Claim 22, it is noted that the principal mechanical ground gripping zone, the secondary position maintenance or gripping zone and the neutral center rear zone are described in the specification at lines 4-9 of column 6.

### III. PRIOR ART REJECTIONS

[Paragraph 7] Claim 28 was again rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Tong. Claim 28 recites that the intermediate layer extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.” As was previously explained, there is no teaching for this structural feature of Tong et al.

For example, the insert member 56 in Tong et al (Figures 4-5) extends only in the heel area of the sole (see Fig. 4). It is thus not present at the fore half of the sole. The insert member is also limited in area by the spaces between the lateral extensions 60-72. Even a cursory examination of Tong et al thus indicates that the insert member 56 extends over *less than one half* of the ground contact layer which is located directly beneath a foot of a person wearing the shoe.

The insert member 120 of Tong et al (Figure 16) is also limited and has significant spaces between the lateral extensions at the heel and between the fingers 122, and so the above remarks regarding insert member 56 apply here as well, i.e., it is limited in extent and cannot reasonably satisfy the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.”

As a separate matter, the insert of Tong et al, due to its shape (Fig. 16), cannot provide torsional rigidity. Its purpose is instead to return energy.

**[Paragraph 8]** Claim 28 was also rejected under 35 U.S.C. § 102 as being anticipated by Barry et al. As previously explained, however, the spring plate 17 of Barry et al is not present at the lateral part of the heel, and so also does not correspond to the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.” Thus the broadest reasonable interpretation of this claim term is not taught by Barry et al.

As a separate matter, Barry et al does not require torsional stiffness. Instead, Barry et al teaches minimizing torsional stiffness so as not to increase the degree and rate of pronation and the potential for injury (col. 5, lines 5-11). Barry et al thus provides the insert for a spring effect and to cooperate with the viscous midsole (col. 3, lines 10-19). Accordingly, Barry et al teaches away from the claimed invention.

**[Paragraph 9]** Claim 29 was rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Misevich. This rejection is rendered moot by the cancellation of Claim 29.

**[Paragraph 10]** Claims 30-32 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. patent 5,025,573 (Giese), the Examiner alleges that Giese shows a shoe



including “a comfort layer (elements above element 31).” However, the specification of Giese does not describe any elements whatsoever above the main bar 31 in these figures, nor are any such overlying elements illustrated in Figures 122-126 of the reference. Applicants therefore fail to find a basis in the reference for this rejection.

**[Paragraph 11]** Claims 1, 2, 14-16, and 24 were rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Fukuoka. However, this rejection is respectfully traversed. Fukuoka is directed to a sandal, not a sport shoe, and so is not material to the claimed invention. Moreover, Fukuoka lacks the combination of a ground contact layer, a cushion layer and an intermediate layer. Rather, in Fukuoka a *hard* core layer 17 is laid on a soft ground contact layer 15, and projections 29, 31 and 33 of the ground contact layer pass through holes of the core layer to lock the two layers together. The Examiner alleges that projections 29, 33 and 31 form a cushion layer. However, the projections 29, 33 and 31 are themselves provided with (hard) cores 30, 32 and 34 (col. 5, lines 15-16), to provide stimulation and not comfort. Thus the projections 29, 33 and 31 cannot provide a cushion layer and Fukuoka does not anticipate any of the claims.

**[Paragraph 12]** Claims 1, 19, 20 and 25 were also rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Salzman. The Examiner there alleges that the insert 30 of Salzman comprises an intermediate layer which covers the entire ground contacting surface. However, Applicants fail to understand the basis for this allegation. It is the ground contact layer in Salzman which is rigid, not the insert. Also, there is no description of the extent of the insert 30 in the specification of Salzman, other than that it provides an arch portion intermediate front and rear portions (column 3, lines 3-6). There is, in particular, no description in the specification that the insert 30 extends over the entire surface of the ground contact layer. Nor is this taught by the figures. The sectional view of Figure 2 is limited to a

single plane; it provides no teaching regarding the extent of the insert 30 on either lateral side of the plane of the figure. Thus, the insert 30 could be significantly limited.

Claim 1 further recites that the ground contact layer is made of rubber. Salzman, on the other hand, is a molded ski boot having a molded plastic ground contact layer which is explicitly described as having better torsional rigidity than rubber (col. 1, line 40), i.e., *it teaches against the use of rubber*. The claims thus define over this reference.

**[Paragraph 14]** Claims 1, 17, 18, and 28-31 were rejected under 35 U.S.C. § 103 as being obvious over Misevich in view of Giese. Initially, it is noted that the plate 37 of Misevich is buried in the mod-sole 44-46, and so is not in contact with the ground contacting layer. Moreover, the plate 37 of Misevich et al has a limited extent. In apparent recognition of this fact, the Examiner has alleged it would have been obvious in view of Giese to extend the plate 37 of Misevich into the metatarsal area and to form a series of rigid inserts. However, even if this were indeed obvious to those skilled in the art, no combination of the above references would have rendered obvious the subject matter of the rejected claims.

For example, Claim 1 recites that the intermediate layer extends over an entire surface of the ground contact layer. While, as already noted, the word “entire” must be understood in light of the original disclosure, including Claims 17, 19 and 24, the main bar 31 of Giese extends only over the central portion of the heel, and not to the rear or lateral sides. Moreover, the flex bars 31A are completely separate from the main bar 31 and are themselves limited to the center portion of the sole. Indeed the main bar 31 and flex bars 31A of Giese extend over only about one half of the sole area and cannot conform to the plain meaning of an intermediate layer extending over an entire surface of the ground contact layer (Claim 1) or any reasonable interpretation of an intermediate layer extending over substantially the entire surface of the ground contact layer (Claims 28, 30 and 31).

**[Paragraph 15]** Claims 1, 2, 4-14, 21-23 and 25-29 were rejected under 35 U.S.C. § 103 as being obvious over Misevich in view of either the U.S. patent to Hannibal and to Kurash. Again, in evident recognition of the limited extent of the plate 37 of Misevich, the Examiner has relied upon either Hannibal or Kurash to suggest extending the stiffening layer to cover the entire surface of the ground contact layer. However, this is also respectfully traversed.

Element 36 of Kurash et al is merely a mid-sole. It is not described as having controlled torsional and flexional rigidity. Indeed, Kurash et al instead provides the cross bar stabilizer 48 (column 3, lines 6-10) for this purpose. The mid-sole of Kurash et al thus cannot suggest such an intermediate layer in Misevich.

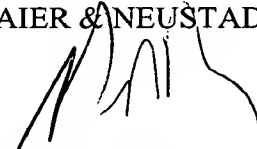
The element 30 of Hannibal is simply an inner sole, and not a reinforcement. Also, it is separated from the comfort layer and is not arranged directly between the comfort layer and the ground contact layer. Thus, no combination of the above references would anticipate or render obvious the subject matter of any of the claims.

**[Paragraph 16]** Claim 3 was rejected under 35 U.S.C. § 103 as being obvious over any of the previously applied references, and further in view of Banich, which was cited to teach providing a mid-sole having zones of different material properties. However, whatever teaching Banich may have in this respect, it would not overcome the shortcomings of the primary references as discussed above, and so no combination of the above references would have rendered obvious the subject matter of any of the claims.

Applicants therefore believe that the present application is in a condition for allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

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IN THE CLAIMS

Please amend the claims as follows:

14. (Amended) Sole according to claim 1, wherein said intermediate layer [or rib] (9A) is constituted by a plurality of zones (9a, 9b, 9c) extending on either side of an axis of torsion (X-x') whose stiffness values are different and suitably selected during manufacture as a function of the intended use of the shoe.

17. (Amended) Sole according to claim 1, wherein said rigid intermediate layer[, or rib] (9B) is constituted, at least in the metatarsal area, by a succession of rigid inserts (10) arranged in alternating fashion perpendicularly to the axis of torsion (X-X') of said sole, so as to obtain good flexibility under flexion while preserving good stiffness under torsion.

19. (Amended) Sole according to claim 1, wherein said intermediate layer [or rib,] (9C) comprises, in proximity to its front and rear portions, two arc-shaped recesses (11a, 11b) substantially corresponding to the ends of said sole and capable of allowing passage of two stops (12, 13) formed from said contact layer (7) and on the inner surfaces of which parts of the upper (3) are adhesively bonded.

20. (Amended) Sole according to claim 19, wherein a shoulder (14, 15) perpendicular to the outer surfaces of said stops (12, 13) remains between [the latter] said stops and the plane of said [rib] intermediate layer (9C) so as to produce an attachment designed for installation of ice studs, in a high mountain boot.

21. (Amended) Sole according to claim 1, wherein said comfort layer (8A) comprises, in its rear part, a balanced heel-piece (6A) produced as a single piece with said layer (8A) [and replacing the outer heel-piece (6) of said shoe (1)].

23. (Amended) Sole according to claim 1, wherein said ground-contact layer (7B) is formed from skids mounted externally on said [rib] intermediate layer (9) in recesses (20) provided in the latter for that purpose.

24. (Amended) Sole according to claim 1, wherein said comfort [zone] layer is constituted by points (8b) made of the material on the upper part (7a) of said contact layer (7), and which pass through said intermediate layer, [or rib] (9D) [and clear it by a value equal to the thickness of said comfort layer to be produced].

25. (Amended) Sole according to claim 1, [wherein said rigid intermediate layer, or rib, (9E) allows mechanical attachment of] further comprising a hinge-type binding loop (21) [in an application to cross-country ski or Nordic hiking boots, comprising or not an inner metal strengthening insert, said insert and/or said loop (21) being] duplicate molded in said rigid intermediate layer (9E).

26. (Amended) Sole according to claim 1, wherein said rigid intermediate layer[, or rib](9) can allow mechanical attachment of an insert cooperating with an associated binding for assembly of said sole to an element such as a ski, cycle pedal, etc., said insert being duplicate molded in said rigid intermediate layer [9)] (9).

27. (Amended) Sole according to claim 21, wherein said intermediate layer[, or rib] (9F) can allow mechanical attachments of studs in a screw-in configuration in an application to golf shoes.

Cancel Claim 29.